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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David Shen

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06/27/2008

BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE

P.O. BOX 10395

CHICAGO, IL 60610

EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

06/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,168	Applicant(s) SHEN ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-19 fail to meet the above requirements because the claims fail to tie in another statutory class of invention.
3. Claims 20-36 are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted to be a computer program, does not fall within at least one of the four statutory categories of invention enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). Computer programs are nonstatutory functional descriptive material (MPEP § 2106.01.I, last para.).
4. Claims 2, 5-8, 15 and 17-36 are rejected under 35 U.S.C. 101 because the claimed invention cannot produce a concrete (i.e., repeatable) result (MPEP § 2106.IV.C.2(2)c)). The invention uses subjective inputs (data points) or explicitly produces subjective performance scores.
5. Assuming the applicant intends “an Evaluator” to be a functional part of the claimed invention, claims 3, 4, 13, 16, 21, 22 and 32 are rejected under 35 U.S.C. 101 because an invention cannot encompass a human being (MPEP § 2105, last para.).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 2, "the text comments" lacks antecedent basis.

Applicability of 35 USC 112, 6th Paragraph

8. It appears the applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 20-36 by using "means-plus-function" language, such as "means for collecting" (claim 20 line 3). In order to successfully invoke the sixth paragraph, a three-prong test must be met (MPEP § 2181.I): (1) the claim limitations must use the phrase "means for" or "step for"; (2) the "means for" or "step for" must be modified by functional language; and (3) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function. The above claims pass the three prong test, so 35 U.S.C 112, 6th paragraph has been successfully invoked. The Examiner will consider the means to perform the claimed functions as the means disclosed, specifically in para. [0096] *et seq.* of the published application (US 20040204983A1).

Claim Rejections - 35 USC § 102 and 35 USC § 103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-9, 11, 14, 16-28, 30 and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (US 20020042738A1).
12. Srinivasan et al. teaches (independent claims 1 and 20) a method and computer application for evaluating/determining the performance of an ad, the method comprising:
 - collecting a plurality of input data points (*different formats of the same advertisement*, para. [0029], and *experiment parameter values*, para. [0059]);
 - collecting a plurality of outcome data points (*statistics on the audience response*, para. [0029], *output from the Server Module 260*, para. [0059]); and
 - calculating one or more performance scores (*optimal values of key market decision variables*, para. [0025], *statistics on the audience response*, para. [0029], and *the buy-rate*, para [0086]) based upon the input and output data points.
13. Srinivasan et al. also teaches at the citations given above claims 2, 6-8, 9 (inherently, to gather *statistics on the audience response*), 14, 16, 18, 24-26 and 28.
14. Srinivasan et al. also teaches: claims 3, 4, 21 and 22 (para. [0058], where *an employee* reads on “an Evaluator”); claims 5 and 23 (para. [0087]); and claims 11, 17, 19, 27, 30 and 34-36 (para. [0049]).
15. Claims 10, 12, 13, 15, 29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al. (US 20020042738A1). Srinivasan et al. does not teach (claims 10 and 29) a pop-up window and (claims 12, 13, 15 and 31-33) soliciting comments that are analyzed for key words. However, the reference does teach determining the *audience response* (para. [0029]) and that *surveys* of the audience are common (para. [0022]). Official notice is taken (MPEP § 2144.03) that pop-up windows were a common means of presenting surveys at the time of the instant invention. Asking for comments in the surveys was also common, and key-word analysis would have been an obvious mechanical efficiency in analyzing these comments.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
17. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

21 June 2008

/Donald L. Champagne/
Primary Examiner, Art Unit 3688